

## REMARKS

This Amendment is filed in compliance with 37 CFR §1.111, and in response to the Office Action mailed on the 30<sup>th</sup> of June 2006, Paper No. 20060623. Entry of the following amendments, re-examination and reconsideration are respectfully requested.

### **Listing of the Claims**

Pursuant to 37 CFR §121(c), the claim listing, including the text of the claims, will serve to replace all prior versions of the claims, in the application.

### **Status of the Claims**

Claims 1 through 23 are pending in this application.

### **Amendment of the Claims**

Claims 5, 6, 11 through 15, 17, 19 and 21 are amended in various particulars, to adopt suggestions kindly offered by the Examining staff in Paper No. 20060623.

### **Failure to accept Applicant's Proposed Figure 8**

Paper No. 20060623 states that Applicant's Figure 8,

"has not been accepted by the examiner because it illustrates new matter. Specifically, the location of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor is new matter."

Initially, the Examining staff objected to the drawings under 37 C.F.R. §1.83(a) as failing to show every feature of the invention specified in the claims. The Examiner required indication of the conveyor elements, insertion stations, adhesion stations, collection stations, and conveyor devices in the drawings. As explained during the Office interview, the objection is unfounded in each of the following six instances noted by the Examiner's

comments.

**Second**, the averment by Paper No. 20060623 that Applicant's Figure 8,

"illustrates new matter. Specifically, the location of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor is new matter",

is a conclusion, rather than a statement of fact; moreover, the conclusion that Applicant's Figure 8,

"illustrates ... ***the location*** of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor",

is unsupported by a cursory consideration of Figure 8. Furthermore, the *Detailed Description* explains that,

"[i]nstead of an inserting station 58 or additionally to this[,] one may provide further working stations such as e.g. an adhesion station for adhesing cards or sample packages or likewise. Also radially on the outside along the revolving conveyor means 30' one may arrange such adhesing stations, feeders for laying on further printed products, a further stapling station in the form of a stapling apparatus or combinations of these working stations."<sup>1</sup>

These passages expressly describe "***the location of*** additional work stations complementing "inserting station 58" already illustrated by Figure 3; Figure 8 illustrates the relative juxtaposition of such exemplary work stations, for example stations 90, 92, 96, 98, 100, and 102" defined by the original claims, relative to the conveyor 30'. In short, the conclusory statement of Paper No. 20060623 that:

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<sup>1</sup>      *Detailed Description*, paragraph [0047], page 18, beginning at line 13.

“the location of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor is new matter”,

is a conclusion that is contradicted by the express teachings of Applicant’s originally filed specification. Under law,<sup>2</sup> no amendment may introduce “new matter.” Here, the foregoing excerpts are from Applicant’s originally filed application. Consequently, no amendment has introduced “new matter” into the application, and the Examining staff has neither asserted that Applicant’s amendment’s of either the 24<sup>th</sup> of April or 22<sup>nd</sup> of May 2006 introduced “new matter” into the specification or that Applicant’s amendment in fact contained “new matter.” Withdrawal of this objection is therefore respectfully urged.

**Third**, the assertion that,

“the location of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor is new matter”,

is a tautology rather than an observation of fact. Simply stated, any drawing which purports to show both conveyor 30’ and any work station necessarily, and inescapably shows some “location of” one or more work stations “in relation to the conveyor . . .” Consequently, the mere presence of both elements in the same drawing shows some sort of location of one relative to the other. Here, Figure 3 already shows such location, and the *Detailed Description* already describes that location. Accordingly, the Examiner is respectfully requested to either (i) accept the teachings of the *Detailed Description* explaining that work station 58 is exemplary and representative of other work stations which may be deployed

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35 U.S.C. §132(a). No amendment shall introduce new matter into the disclosure of the invention.

either individually or in combination with work station 58 and one or more other work stations, or (ii) withdraw the requirement for an addition drawing to illustrate:

“indication of the conveyor elements, insertion stations, adhesion stations, collection stations, and conveyor devices in the drawings”,

imposed by Paper No. 20060623. Such action is respectfully urged.

**Fourth**, “the conveyor” presented in Applicant’s Figure 8 is copied from the original drawing of Figure 3, which already illustrates with a level of detail commensurate with the written text of the *Detailed Description*, “the location of [insertion] station ... [58] *in relation to the conveyor*.” The “insertion station 58” illustrated in Figure 3 is an exemplar of the detail applicable to all of the stations. Applicant’s Figure 8 copies the same relation shown by Figure 3. Recognizing that “the location” of an exemplary work station in relation to the conveyor which Paper No. 20060623 labels as *new matter* is already illustrated in Figure 3, the repetition of Figure 3 to show “the location of stations 90, 92, 96, 98, 100, and 102 *in relation to the conveyor*” can not constitute new matter. Accordingly, Figure 8 presents no *new matter*.

**Fifth**, original claim 9 expressly defines “the location of stations 90, 92, 96, 98, 100, and 102 *in relation to the conveyor*.” Thus, Applicant’s Figure 8, conforms with the *Detailed Description* which teaches, *inter alia*,

“Instead of inserting station 58 or additionally to this one may provide further working states such as e.g., an adhesion statin for adhesing cards or sample packages or likewise. ... The number, type and sequence of working stations may be combined with one another in a useful manner along the

revolving conveyor means 30””.<sup>3</sup>

Figure 8 illustrates this teaching of the *Detailed Description* to show “the location of stations 90, 92, 96, 98, 100, and 102 in relation to the conveyor”; this illustration of the teachings of the *Detailed Description* can not constitute new matter. Accordingly, Figure 8 presents no *new matter*.

**Sixth**, the attention of the Examiner was invited during the Office interview to note that “conveyor elements” is used collectively to refer, in the aggregate, to the several constituent components of the various conveyors described in the *Detailed Description*, several of which components are individually shown in the drawings. This sixth instance is confirmed by the record now before the Examining staff, and has apparently not been considered by Paper No. 20060623. Consequently, Paper No. 20060623 is incomplete under 37 CFR §1.104(a) and (b). Completion by reconsideration of the entirety of the record and clarification in accordance with 37 CFR §1.104(a) and (b) is respectfully requested in subsequent, non-final Office correspondence, in order to accord Applicant an opportunity to fairly respond.

**Seventh**, the attention of the Examiner was directed during the Office interview to note that rather than the nominative phrase “insertion station” mentioned in Paper No. 04072005, Applicant illustrates “inserting station 58”, with some degree of detail, in Figure 3. Moreover, the *Brief Description of the Drawings*, among other portions of Applicant’s

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*Detailed Description*, page 18.

specification, expressly identifies this feature. This seventh instance is confirmed by the record now before the Examining staff, and has apparently not been considered by Paper No. 20060623. Consequently, Paper No. 20060623 is incomplete under 37 CFR §1.104(a) and (b). Completion by reconsideration of the entirety of the record and clarification in accordance with 37 CFR §1.104(a) and (b) is respectfully requested in subsequent, non-final Office correspondence, in order to accord Applicant an opportunity to fairly respond.

**Eighth**, the Examiner questioned that absence of “adhesion stations” and “collection stations” in the drawings. During the Office interview, it was noted that these various assemblies are conventional, and their respective connections to Applicant’s invention are duly represented by the, insertion station illustrated in Figure 3, in compliance with the last clause of 37 CFR §1.83(b), and as also indicated by “straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100”, together with “drying station 102” illustrated as rectangular boxes in Figure 9 of Müller ‘278.<sup>4</sup> As explained in paragraph [0010] of Applicant’s original specification, “adhesive binding is shown in detail in EP-A1-0675005.” Although Figure 3 represents “an inserting station which is located “radially on the inside”<sup>5</sup>, what is significant here is the,

“large accessibility radially on the inside as well as radially on the outside and from the side ... possible to provide further

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<sup>4</sup> See column 8, lines 27 through 65 of Müller, U.S. Patent No. 5.562.278, which is assigned to the instant Applicant.

<sup>5</sup> Original Specification, paragraph [0047], line 3.

working stations along the revolving path 31 . . .”<sup>6</sup>

Figure 3 provides an exemplary degree of illustration of these connections between these different constituent components of Applicant’s inventions, in conformance with the last clause of 37 CFR §1.83(b). Accordingly, reconsideration of this requirement is respectfully requested. Should, upon reconsideration, the Examiner deemed that amended drawings are necessary, or even desirable, Applicant will submit additional figures using boxes to represent “adhesion stations” and “collection stations”. This eighth instance is confirmed by the record now before the Examining staff, and has apparently not been considered by Paper No. 20060623. Consequently, Paper No. 20060623 is incomplete under 37 CFR §1.104(a) and (b). Applicant renews its earlier request for completion by reconsideration of the entirety of the record and clarification in accordance with 37 CFR §1.104(a) and (b) is respectfully requested in subsequent, non-final Office correspondence, in order to accord Applicant an opportunity to fairly respond.

Ninth, the Examiner questioned the absence of “conveyor devices” in the drawings. The Examiner was invited during the Office interview to note “conveyor device 30” among features shown in Figure 5. This ninth instance is confirmed by the record now before the Examining staff, and has apparently not been considered by Paper No. 20060623. Consequently, Paper No. 20060623 is incomplete under 37 CFR §1.104(a) and (b). Completion by reconsideration of the entirety of the record and clarification in accordance

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Original Specification, paragraph [0047], lines 2 and 3.

with 37 CFR §1.104(a) and (b) is respectfully requested in subsequent, non-final Office correspondence, in order to accord Applicant an opportunity to fairly respond.

During the interview, Applicant's attorney observed that insertion station 58 illustrated in detail by Figure 3 is a representative of other types of "work stations", in compliance with both the last clause of 37 CFR §1.83(b) and the convention followed by the U.S. Patent & Trademark Office in Müller '278; by way of example, Figure 7 of Müller '278 shows a "straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100 [which] are arranged one behind the other along the upper stand 72 ... [and] a drying station 102." Each of "straightening station 90, milling station 92, precision-machining station 94, glue-applying station 96, cover-supplying station 98 and pressing-on station 100 [and] drying station 102" is represented by a rectangular box. Although 37 CFR §1.83(b) requires no more, Applicant here has additionally illustrated the details of a representative work station 58 in Figure 3.

#### Objection to the Drawings

Paper No. 20060623 newly objected to the drawings with an assertion that:

"the bending elements integrated with the second rests, binding station, adhesion stations, and collections [*sic*, "collection"] stations must be shown or the feature(s) cancelled from the claims(s)."

Paper No. 20060623 fails to identify the origin of the excerpted language. Utterly absent from Paper No. 20060623 is any explanation of how the Examining staff came to believe that

“the bending elements” has some relation to such other features as “adhesion stations” or “collection stations.” No pending claim uses this language; consequently, there is no basis under 37 CFR §1.83(a) for imposing this objection. Moreover, Applicant’s *Summary of the Invention* clearly explains that,

“The distance of the stapling heads is matched to the distance of the rests which these have to one another in the region of the stapling station. The stapling heads during stapling move synchronously to the rests in a plane running transversely to the rests and for stapling cooperate with benders in the rests”.<sup>7</sup>

“If bending mechanisms are integrated into the second rests, then a binding apparatus may be allocated to the conveyor path at various locations.”<sup>8</sup>

Figure 7 clearly illustrates “an embodiment form of a rest with an integrated bending mechanism.”<sup>9</sup> The specification additionally explains that in Figure 7:

“[t]he second rests 32 in the example shown here comprise integrated bending means 57, as are shown in Fig. 7 or are for example known from EP-B-0399317. It is also conceivable for the stapling apparatus 50 to comprise a bending means which for example is fastened on a carrier arm pivotably arranged on the stapling apparatus 50 whose position of pivoting may be controlled. The pivot positions are controlled such that the bending means in each case laterally below the saddle 34 which is just introduced to the printed products 12 to be stapled and for stapling cooperates with the stapling heads 54 of the stapling apparatus 52. On account of the bending means available in the whole revolving conveyor means 30’, the constant distance a of the saddles 34 to one another and the good support of the second

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<sup>7</sup> Original specification, page 5, lines 2-5.

<sup>8</sup> Original specification, page 10, lines 8-10.

<sup>9</sup> Original specification, page 12, line 12.

rests in or on the rails 28, 28' which introduce the occurring forces into the frame 26, the stapling apparatus 52 may be applied in the example here in the region of the complete upper side belt face of the revolving conveyor means 30' without any problem and without the need for retrofitting.”<sup>10</sup>

“there is shown a further embodiment form of a second rest 32. In the example shown here a bending means 57 is integrated into the second rest 32. The bending means 57 is arranged on that side of the second rests 32 lying opposite to the printed products. It comprises two lever means 68 pivotable into the lateral end regions 64 of the rests 32 about the rotating axes 66, with in each case two lever arms 70, 70' lying opposite one another. On the lever arms lying opposite one another there is mounted a carrier element 72 which extends parallel to the longitudinal extension L2 of the second rests 32 and on which there are supported two punches with associated benders 76, said punches being distances to one another. The punches 74 with the benders 76 are arranged on the carrier element 72 such that they may cooperate with the stapling heads 54 of the stapling apparatus 52 arranged on the revolving conveyor means 30'. Pressure elements 78 which may be activated controlled by sliding blocks (arrow 80) are actively connected to the respective second lever arms 70' of the lever means 68. The stapling heads 54 pierce U-shaped wire sections through the collected printed products 12 and the wire ends of these protrude. If the pressure elements 78 press the second lever arm 70' away from the saddle 34 of the rest 32, then the carrier element 72 is pressed by the second lever arm 70' in the direction of the saddle 34 and the punches 74 actuate the benders 76 which bend the projecting wire ends.”<sup>11</sup>

These excerpts from Applicant's specification both illustrate and explain in substantive detail, how “the bending elements [are] integrated with the second rests ...” for several

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<sup>10</sup> Original specification, page 17, lines 12-21, and page 18, line 1.

<sup>11</sup> Original specification, page 20, lines 10-21, and page 21, lines 1-3.

embodiments of the principles of Applicant's inventions. This objection is therefore unfounded; its withdrawal is respectfully requested.

Moreover, the objection is improper under 37 CFR §1.83(a).

A replacement drawing of Figure 8 accompanies this paper.

**Objection to the Specification**

Paper No. 20060623 newly objected to the specification on grounds that the specification refers to Applicant's "Figure 8 which is not currently in the drawings." This assertion is incorrect because Paper No. 20062306 expressly recognizes Applicant's proper filing of a Request for Continued Examination, and confirms that:

"Applicant's submission filed on 4/24/06 *has been entered.*"

Figure 8 was included among "Applicant's submission filed on 4/24/06." Accordingly, the entry of Applicant's drawing with that "submission" negates the basis of this objection. Its withdrawal is respectfully requested.

**Claim Rejection Under First Paragraph Of 37 C.F.R. §112**

Paper No. 20060623 rejected claims 17 through 23 under the first paragraph of 37 C.F.R. §112. Applicant respectfully traverses this rejection for the following reasons.

**Claim 17**

Paper No. 200060623 bases this rejection under the first paragraph of 37 C.F.R. §112 and questions whether the language of claim 17,

"a conveyor assembly selectively alignable spaced-apart from an end of the collection drum",

has support in the disclosure as filed. Applicant respectfully confirms that this language has enablement in the assertion, and directs the attention of the Examining staff to the *Detailed Description* which states, *inter alia*, that,

“revolving conveyor 30’ shown by way of example is equipped with two axes 36, 36’ which are arranged essentially parallel to one another . . . . the first axis 36 here is arranged flush with the drum axis of the collection drum 14.”<sup>12</sup>

This feature is illustrated by Figures 2 and 4. The original specification additionally explains that,

“[i]n the region of the first axis 36 the first deflection 44 in the embodiment example shown here is designed such that those sides of the second saddles 34 adjacent the collection drum end 24 in a transfer region 50 of the revolving conveyor 30’ are guided parallel to the saddles 20 of the first rests 18 of the collection drum 14 on concentric circular arc sections, which lie on essentially parallel planes neighboring one another and have the same radius. It is also conceivable for the circular arc sections to lie on planes aligned *inclined* to one another, this particularly being the case if the second rests 32 with their longitudinal extension are aligned at an angle deviating by 90° transversely to the conveying direction F. The circular arc sections may also be slightly *displaced* to one another instead of being concentric or may also have different radii. With all these variants it is just a question that a transfer of the printed products from the collection drum 14 to the revolving conveyor means 30’ e.g. using conveyor elements of the collection drum, is able to be carried out without any problem. Instead of providing the second deflection means 44’ with a second axis 36’ arranged parallel to the first axis 36 at the same height, as shown in Fig. 1, the second axis 36’ of the diverting means 44’ may also be *displaced* in height or e.g. with an S-shaped rail guide between the diverting means 44, 44’, may be arranged

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*Detailed Description*, paragraph [0014], page 14, beginning with line 14.

laterally *displaced* to the first axis 36. The rail radius of the second deflection means 44' may *deviate* from the first deflection means 44 and may be larger as well as smaller. These possibilities of designing the revolving conveyor means 30' open up a great potential in space use possibilities.”<sup>13</sup>

It may be appreciated that if, by way of the several examples given in the foregoing excerpt from Applicant's original specification in which either the planes, axes or constituent components of the **collection assembly** and the **conveyor assembly** are in the various ways detailed by the specification, either *inclined*, *displaced* or arranged to *deviate*, in any manner other than in a configuration other than in with axes 36, 36' are precisely parallel, there is some part, or all of the **collection assembly** and the **conveyor assembly** are both *selectively alignable* and *positionally spaced-apart* to some extent, with *a second axis displaceable from coaxial alignment with said drum axis* to some degree. Accordingly, there is no factual basis for questioning the enablement of claim 17.

Despite the absence of factual basis for this rejection, Applicant has taken this opportunity to broaden the scope of claim 17 to read “a conveyor assembly selectively alignable ~~spaced-apart from and end in proximity with the terminal portion of the collection drum~~”. Accordingly, the basis for this rejection is moot.

### **Claim 19**

Paper No. 200060623 bases this rejection under the first paragraph of 37 C.F.R. §112 upon an assertion that the language of claim 19,

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<sup>13</sup> Original specification, page 16, lines 10-21, and page 17, lines 1-5.

“a conveyor assembly positionably spaced-apart from said terminal portion to rotate around a second axis displaceable for coaxial alignment with said drum axis”,

has no support for this limitation in the disclosure as filed. Applicant respectfully denies this assertion, and directs the attention of the Examining staff to the *Detailed Description* which states, *inter alia*, that “revolving conveyor 30’ shown by way of example is equipped with two axes 36, 36’ which are arranged essentially parallel to one another . . . the first axis 36 here is arranged flush with the drum axis of the collection drum 14.”<sup>14</sup> “For the movement of the rests in the conveyor direction F, in the example shown here a conveyor unit is fastened on the frame 26 which is actively connected to a conveyor (not shown) which is guided in the rail 28’ next to the saddle and which is in engagement with the carriage 38’ of the second rests 32. The conveyor unit by way of a gear for example, is connected to the motor 17 which drives the collection drum which simplifies the matching of the conveyor speed in the conveyor path 31 to the rotation speed of the collection drum 14. A *separate motor* for the conveyor unit 35 of the conveyor is also conceivable.”<sup>15</sup>

Elsewhere, the *Detailed Description* states that “the region of the first axis 36 the first deflection 44 in the embodiment example shown here is designed such that those sides of the second saddles 34 adjacent the collection drum end 24 in a transfer region 50 of the revolving conveyor 30’ are guided parallel to the saddles 20 of the first rests 18 of the

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<sup>14</sup> *Detailed Description*, paragraph [0041], page 14, beginning with line 14.

<sup>15</sup> *Detailed Description*, paragraph [0043], page 15, beginning with line 13.

collection drum 14 on concentric arc sections, which lie on essentially parallel planes neighboring one another and have the same radius. It is also conceivable for the circular arc sections *to lie on planes aligned inclined to one another*, the particularly being the case if the second rests 32 with their longitudinal extension are aligned at an angle deviating by 90° transversely to the conveying direction F. The circular arc sections may also *be slightly displaced* to one another instead of being concentric or may have different radially.”<sup>16</sup> This is what is illustrated by Figures 2 and 4.

Despite the absent of factual basis for this rejection, Applicant has taken this opportunity to broaden the scope of claim 17 to read “a conveyor assembly positionably spaced-apart from in proximity with said terminal portion to rotate around a second axis displaceable from coaxial alignment with said drum axis . . . .” Accordingly, the basis for this rejection is moot.

**Rejection Of Claims 5-8 & 11-15 Under Second Paragraph 35 U.S.C. §112**

In Paper No. 20060623, claims 5 through 8 and 11 through 15 are rejected under the second paragraph of 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The basis for this rejection are identified as:

- a.     Claims 5 and 6 appear to be duplicates of claims 7 and 8. Are the elements in claims 7 and 8 the same elements as in 5 and 6?

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<sup>16</sup>     *Detailed Description*, paragraph [0045], page 16, beginning with line 10.

- b. Claim 6 recites the limitation “at least one rail”. Is this the same rail as recited in claim 5?
- c. Claim 8 recites the limitation “at least one rail”. Is this the same rail as recited in claim 7?
- d. Claims 11-15 recite the limitation “the conveyor means”. There is insufficient antecedent basis for this limitation in the claim.
- e. Regarding claim 13, the phrase “preferably” renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Although Applicant disagrees with the basis for this rejection, claims 5 through 8 and 11 through 15 are amended in conformance with the suggestions kindly offered by the Examining staff. Accordingly, this rejection is rendered moot.

**Claim Rejection Under 35 U.S.C. §102(b)**

Claims 1, 2, 5 through 13, 17, 19 and 21 through 23 are rejected under 35 U.S.C. §102(b) as being anticipated by the Assignee’s previously issued Müller, U.S. Patent No. 5,562,278. Applicant traversed this rejection in the written response timely filed on the 13<sup>th</sup> of October 2005. During the Interview, Applicant’s undersigned attorney explained that the rejection was unsustainable for the following reasons.

- 1. **Paper No. 04072005 does not teach every element of claims 1, 2, 5 through 13, 17, 19 and 21 through 23 as is demanded to demonstrate anticipation of the invention defined by the pending claims under 35 U.S.C. §102(b).**

35 U.S.C. §102(b) provides that an Applicant is entitled to a grant of a patent, unless:

“the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.”

As interpreted and applied under current U.S. Office practice established by 35 U.S.C. §102(b), no claim may be rejected under 35 U.S.C. §102(b) unless:

“[t]he identical invention ... [is] shown in as complete detail as is contained in the ... claim”.<sup>17</sup>

In support of this rejection however, the Examining staff argues that,

“The applicant states that Muller does not disclose that the conveyor means in the transfer region is arranged adjacent to a collection drum end of the collection drum. In response, the Examiner notes that Muller discloses a convey device that is arranged adjacent to a collection drum end of the collection drum (see at least applicant’s specification as filed, paragraph 0010).”<sup>18</sup>

This rationale endeavors to justify a denial of patentability by focusing exclusively upon a single phrase in claim 1, “wherein the conveyor device in the transfer region is arranged adjacent to a collection drum end of the collection drum”, and a single phrase in claim 16, “a conveyor assembly arranged adjacent to a collection drum end of the collection drum”.

35 U.S.C. §102(b) however, demands evidence that “**the invention** [as opposed to a single feature of *the invention*] was patented or described in a printed publication” while the second

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<sup>17</sup> §2131 of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 3, August 2005, citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

<sup>18</sup> Paper No. 20060623, page 11, and originally, Paper No. 11152005, page 3.

paragraph of 35 U.S.C. §112 states that the claims define “the subject matter which the applicant regards as his *invention*.” Applicant is concerned that the focus by the Examining staff upon a single phrase in claims 1, 16 and 17, and a comparison of those phrases with the Background discussion of Applicant’s original specification<sup>19</sup> is somewhat less evidence of anticipation that contemplated by 35 U.S.C. §102(b), particularly in view of the failure of the Examining staff to consider the remainder of claims 1 and 16. The adjective *adjacent* is known for its breath and scope as a description of spatial relations; the fact that the same adjective may be used to broadly describe attributes of both the existing art and the Applicant’s invention is not persuasive evidence of anticipation under 35 U.S.C. §102(b).

By way of a first demonstration, claim 1 defines a structure in which, “for the second rests movable in the conveyor path there is provided a conveyor unit *detached* from the collection drum” while claim 16 defines a structure with “a conveyor unit *detached* from the collection drum”. A structure with these attributes is wholly absent from the Müller ‘278 patent; in contradistinction, the Müller ‘278 patent teaches that:

“[t]he separating elements 42 are spaced apart by a distance A, and are carried by an endless drawing member 46, for example two chains 46’... the endless conveyor member 46 or chains 46’ are guided around the **supporting element 16 of the processing drum 14** and a cylindrical drum-like deflection member 48.”<sup>20</sup>

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<sup>19</sup> Applicant’s original specification states that [t]he revolving conveyor means is arranged adjacent to the collection drum end.”, page 6, lines 1 and 2.

<sup>20</sup> The significance of this passage of Müller ‘278 is the complete structural and operational integration of circulating conveyor 40 and processing drum 14, wholly devoid of Applicant’s teaching of “a conveyor unit detached from the collection drum.”

In other words, in Müller ‘278 conveyor member 16 is both structurally and functionally integrated with both the supporting structural frame and the chain drive mechanism of the processing drum 14. Physically, as illustrated by both the O.G. Figure and by Figure 1, conveyor unit 14 is located between, and serves to physically separate, feeding stations 28 and 30 along separated axially lengths of processing drum 14.

Where is any suggestion of “detached” in the prior art? In other words, the art represented by the Müller ‘278 patent is incapable of teaching Applicant’s structure with “a conveyor unit detached from the collection drum.”<sup>21</sup>

By way of a third demonstration of a lack of anticipation under 35 U.S.C. §102(b), a thorough reading of the Müller ‘278 patent reveals that the Müller ‘278 patent nowhere uses either the verb *detach* or *detached*.<sup>22</sup> In contradistinction, Applicant alone teaches that,

“[a]ccording to the invention, the device for conveying the second rests in the conveyor path of the conveyor means comprises a conveyor unit released detached from the collection drum. Since thus no part of the collection drum is an integral component of the conveyor means, it becomes possible to place the conveyor path in the room more or less independently of the collection drum and to transfer the printed products to the conveyor means in any region of the conveyor path.”<sup>23</sup>

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<sup>21</sup> Claim 1, lines 15 and 16, and claim 16, line 10.

<sup>22</sup> To paraphrase the Board of Appeals & Interferences, how can Müller *et al.* ‘278 be said to anticipate Applicant’s “conveyor unit detached from the collection drum” defined by claim 1 when Müller *et al.* ‘278 nowhere even uses Applicant’s term *detached*? This rejection is specious and without factual basis.

<sup>23</sup> Original specification, page 7, lines 10-16.

Consequently, the statements set forth in Paper No. 20060623 that:

9. Regarding claim 16, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably drivable about a drum axis (12) and comprised of first rests (18) with first saddles (20), the first rests being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), as well as conveyor elements (34) for conveying the printed products on the first saddles in the axial direction along the firsts rests; and comprising a conveyor assembly (40) arranged adjacent to a collection drum end of the collection drum to accommodate transfer of the printed products between the collection drum end and the conveyor assembly, comprising a conveyor path (see Fig. 2) with a conveyor direction (u) deviating in a transfer region (50') from the axial direction, second rests (42), a conveyor unit (48) *detached* from the collection drum, disposed to propel the second rests along the conveyor path, and second saddles (52) arranged distanced apart from one another and arranged transversely to the conveying direction.

h. Regarding claim 17, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably driveable about a drum axis (12), the collection drum (14) comprising a terminal portion bearing first rests (18) with first saddles (20), the first rests (18) being uniformly distributed over a circumference and extending in longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), and conveyor elements (34) disposed to convey the printed products on the first saddles (20) in an axial direction along the firsts rests (18); and a conveyor assembly (40) selectively alignable spaced-apart (see col. 4, lines 50-57) from an end of the collection drum (14) to accommodate transfer of the printed products between the terminal portion and the conveyor assembly(40), the conveyor assembly(40) comprising a conveyor path with a conveyor direction (u) deviating in a transfer region (50') from the axial direction, second rests (42) bearing second saddles (52) arranged distanced apart from one another and arranged transversely to the conveying direction(u), a conveyor unit (48) *detached* from the collection drum and

disposed to propel the second rests around a second axis radially displaceable from said drum axis and along the conveyor path.

i. Regarding claim 19, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably driveable about a hub exhibiting a drum axis (12), the collection drum providing a terminal portion forming a transfer region (50'), the terminal portion comprising first rests (18) bearing first saddles (20), the first rests being uniformly distributed over a circumference and extending in longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), and conveyor elements (34) arrayed to convey the printed products on the first saddles (20) in an axial direction along the firsts rests (18); and a conveyor assembly (40) positionably spaced-apart from the terminal portion to rotate around a second axis displaceable from coaxial alignment (see col. 4, lines 50-57) with the drum axis to accommodate to within a transfer region (50') of the collection drum (14), transfer of printed products between the first rests (18) and a plurality of second rests (42) borne by the conveyor assembly (40) along a conveyor path deviating in the transfer region from the axial direction, by providing alignment (see col. 4, lines 50-57) between the first rests (18) and the second rests (42) within the transfer region (50'), the conveyor assembly (40) comprising a conveyor unit (40) *detached* from the collection drum and disposed to propel the second rests along the conveyor path.

j. Regarding claim 21, Muller discloses a device for collecting and processing folded printed products that includes a collection drum (14) rotatably drivable about its drum axis and comprised of first rests (18) with first saddles (20), the first rests (18) being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis (see col. 3, lines 33-36), as well as conveyor elements (34) for conveying the printed products on the first saddles (20) in the axial direction along the firsts rests (18), and a conveyor device (40) comprising a revolving conveyer (40) having an upper side and a lower side (see Fig. 7), a conveyor path with a conveyor direction (u) which at least in a transfer region deviates from the axial direction, second rests (42) movable in

the conveyor path, and second saddles (52) arranged distanced to one another and arranged transversely to the conveying direction, with the conveyor device in the transfer region arranged adjacent to an end of the collection drum to enable carriage of the printed products to be transferred from an end to the conveyor device or vice versa (see col. 11, lines 5-7), and the second rests (42) being *movable propelled along the conveyor path independently* from the collection drum.”

are unsupported by either the record before the Office or by the express teachings of the Müller ‘278 patent. This rejection may not therefore, be maintained because the evidentiary basis of the finding of anticipation is false.

Additionally, and in contrast to the Examiner’s arguement set forth in paragraph 10(b) Müller *et al.* ‘278 does not disclose that the second rests are movably supported on rails (72). Reference numeral (72) is used to identify the upper strand of the circulating conveyor 40 (Muller: Figure 5 and column 7, lines 8 ff.). Neither does Muller either disclose or suggest the use of rails to support and guide the second rests. The rails according to the present invention are structures which are realized *in addition to* (that is, an improvement over) the strand of the circulating conveyor as known taught by Müller *et al.* ‘278. This deficiency in Paper No. 20060623 is emblematic of the lack of anticipation by Müller *et al.* ‘278.

Where is the completeness of a demonstration of anticipation required under 37 CFR §1.104(a), (b) and (c)?<sup>24</sup>

By way of a third demonstration of a lack of anticipation under 35 U.S.C. §102(b),

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<sup>24</sup> Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 3, August 2005.

the Müller ‘278 patent teaches that:

“[t]he separating elements 42 are spaced apart by a distance A, and are carried by an **endless drawing member 46**, for example two chains 46’... the endless conveyor member 46 or chains 46’ are guided around the **supporting element 16 of the processing drum 14** and a cylindrical drum-like deflection member 48.”<sup>25</sup>

In Müller ‘278 conveyor member 16 is both structurally and functionally integrated with both the supporting structural frame and the chain drive mechanism of the processing drum

14. Specifically, in Müller ‘278:

- “separating elements 42 [of conveyor unit 46 in Müller ‘278] are ... carried by an **endless drawing member 46**;”<sup>26</sup>
- “[t]he endless conveyor member 46 or chains 46’ are guided around the supporting element 16 of the processing drum 14 and a cylindrical drum-like deflection member 48”;<sup>27</sup> and
- “[t]hus in the section 50’ of the movement path of the circulation conveyor 40, the separating elements 42 span the gap between the wall elements 18<sup>28</sup> of the **circulating-conveyor section 26.**”<sup>29</sup>

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<sup>25</sup> Müller ‘278 , column 4, lines 32-37. The significance of this passage of Müller ‘278 is the complete structural and operational integration of circulating conveyor 40 and processing drum 14, wholly devoid of Applicant’s teaching of “a conveyor unit detached from the collection drum.”

<sup>26</sup> Müller ‘278 , column 4, lines 32-34.

<sup>27</sup> Müller ‘278 , column 4, lines 34-38.

<sup>28</sup> Wall elements 18 are arrayed on both sides of conveyor unit 46, as is explained by Müller ‘278 in column 3, lines 32-36: “The wall elements 18 are distributed uniformly along the circumference of the processing drum 14 and their radially outer edges, form saddle-like rests 20 which extend generally parallel to the axis of rotation.”

<sup>29</sup> Müller ‘278 , column 4, lines 49-53.

Where is any suggestion of Applicant's teaching of a conveyor unit (48) *detached* from the collection drum or Applicant's "second rests (42) being *movable propelled along the conveyor path independently* from the collection drum" as is incorrectly asserted by the Examining staff in Paper No. 20060623?

These deficiencies in the interpretation of the art by the Examining staff are persuasive evidence of an utter lack of anticipation. Paper No. 04072005 and Paper No. 20060623 simply do not address every element of claims 1, 16, 17, 19 or 21 as is demanded to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b); moreover, as demonstrated in the foregoing paragraphs, claims 17 through 21 prepared for discussion during the Office interview are readily allowable over the prior art. Withdrawal of this rejection is therefore required under guidance laid down by the Director for the Examining staff.<sup>30</sup>

**2. Paper No. 04072005 fails to demonstrate anticipation of *the invention* defined by pending claims 1, 2, 5 through 13, 17, 19 and 21 through 23 under 35 U.S.C. §102(b).**

First, 35 U.S.C. §102(b) states that an Applicant shall be entitled to a patent unless the invention the invention was patented or described in a printed publication ...." Paper No. 04072005 misrepresents the subject matter described in the Müller '278 patent; specifically, in an effort to support the rejection under 35 U.S.C. §102(b), the Examining staff wrote that,

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§2131 of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 3, August 2005.

“Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)<sup>31</sup> with uniformly distributed saddles (18) and conveyor elements (34); conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46”); a conveyor unit (48); and working stations (82, 74).”<sup>32</sup>

In the language of 35 U.S.C. §102(b), the Examining staff is asserting that Applicant’s invention as defined by the pending claims, was patented by Müller ‘278. Ignoring *arguendo* the question of whether the foregoing excerpt from the Paper No. 04072005 is a true characterization of Müller ‘278, the excerpt is not faithful to the definition of Applicant’s inventions set forth in claim 1 or in newly presented claim 17. Moreover, as is demonstrated in the paragraphs below, this statement is not supported by the evidence of record in this application. Full consideration of all of the evidence of record is required in making a determination of whether Applicant’s invention is anticipated under 35 U.S.C. §102(b).

**Second**, in point of fact, Applicant defines, *inter alia*,

“a collection drum rotatably drivable about its drum axis and comprised of first rests with first saddles, said first rests being uniformly distributed over the circumference and extending in their longitudinal extension parallel to the drum axis, as well as conveyor elements for conveying the printed products on the first saddles in the axial direction along the first rests, and

comprising a conveyor device which comprises a conveyor path with a conveyor direction which at least in a transfer region deviates from the axial direction as well as second rests, movable in the conveyor path, with second saddles

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<sup>31</sup> In point of fact, Müller ‘278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

<sup>32</sup> Paper No. 04072005, page 4.

arranged distanced to one another and arranged transversely to the conveying direction,

wherein the conveyor device in the transfer region is arranged adjacent to a collection drum end of the collection drum in a manner such that the printed products may be transferred from the collection drum end to the conveyor or vice versa,

wherein for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum.”

By way of example of the failure to demonstrate anticipation, there is no indication in Paper No. 20050610 of where Müller ‘278 either teaches a *conveyor device* that “in the transfer region is arranged adjacent to a collection drum end of the collection drum” or teaches that “for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum.” Instead, Müller ‘278 states that,

**“At a first end section** of the processing drum, folded printed products can be deposited in a straddling manner on wall elements of the processing drum by a gripper conveyor. **At a second end section**, located *at the other end of the processing drum*, printed products that have been processed in the processing drum are removed by a gripper conveyor. The apparatus has, one behind the other, a multiplicity of sections to which processing and/or feeding stations are associated. The feeding stations are designed to deposit folded printed products in a straddling manner on top of the printed products which have already been deposited on the wall elements or to introduce inserts, at the correct page, into the compartments defined by the wall elements.”<sup>33</sup>

Although this excerpt from Müller ‘278 describes Honnegar, U.S. Patent 5.324.014, the general concept of a “processing drum” is incorporated into Müller ‘278, which teaches that:

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Müller, *et al.* ‘527, column 1, lines 10-23.

“[t]he processing drum 14 has, at its end region on the left-hand side in FIG. 1, a first feeding section 22.1 and, at the other end region on the right-hand side of FIG. 1, a removal section 24.”<sup>34</sup>

...  
“The circulating-conveyor section 26 is associated with a circulating conveyor 40 which functions to guide the printed products which have been fed to it from the feeding section 22.3 ... for carrying out specific processing steps on the printed products 10, and to guide the latter back to said processing drum 14 ...”<sup>35</sup>

This structure with circulating conveyor 40 deployed between the first feeding section 22.1 at the “end region on the left-hand side in FIG. 1” and “a removal section 24” located “at the other end region on the right-hand side of FIG. 1,” is the antithesis of the structure defined by claims 1 and 16; although Müller ‘278 particularly identifies and details both of the opposite ends of his processing drum 14, nowhere does Müller ‘278 teach a *conveyor device* that “in the transfer region is arranged adjacent to a collection drum end of the collection drum.”

**Third,** Müller ‘278 further teaches that,

“[t]he separating elements are spaced apart by a distance A, and are carried by an endless drawing member 46, or example two chains 46’. the endless conveyor member 46 or chains 46’ are guided around the supporting element 16 of the processing drum 14 and a cylindrical drum-like deflection member 48.”<sup>36</sup>

Claims 1, 16 and 17 define “for the second rests movable in the conveyor path there is

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<sup>34</sup> Müller, *et al.* ‘527, column 3, lines 38-40.

<sup>35</sup> Müller, *et al.* ‘527, column 4, lines 19-25.

<sup>36</sup> Müller ‘278, column 4, lines 32-38.

provided a conveyor unit detached from the collection drum”,<sup>37</sup> “a conveyor unit detached from the collection drum, disposed to propel the second rests along the conveyor path”,<sup>38</sup> and “a conveyor unit detached from the collection drum and disposed to propel the second rests along the conveyor path,”<sup>39</sup> features which a wholly lacking among the specification of Müller ‘278. Consequently *the invention*<sup>40</sup> has been neither patented nor described in a printed publication at any time prior to Applicant’s filing date. Withdrawal of this rejection is therefore required.

**Fourth,** the Examining staff erroneous argues that:

“16. The applicant states that Muller does not disclose a conveyor unit detached from the collection drum. In response, the examiner notes that Muller discloses a conveyor unit detached from the collection drum (see Muller item 48).”

In point of fact, the Examining staff has made these arguments by conveniently ignoring the express teachings of Müller *et al.* ‘278. Specifically, Müller *et al.* ‘278 teaches that,

“[t]he processing drum 14 has, at its *end region* on the left-hand side of FIG. 1, a *first feeding section* 22.1 and, at the other *end region* on the right-hand side of FIG. 1, a *removal section* 24.”<sup>41</sup>

As illustrated in Figure 1, *first feeding section* 22.1 and *removal section* 24 are at the axially

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<sup>37</sup> Pending claim 1.

<sup>38</sup> Pending claim 16.

<sup>39</sup> Pending claim 17.

<sup>40</sup> 35 U.S.C. §102(b).

<sup>41</sup> Müller *et al.* ‘278, column 3, lines 31-41.

opposite extremes of “processing drum 14” while *circulating conveyor* 40 is intermediate between *first feeding section* 22.1 and *removal section* 24. In short, and contrary to the argument of the Examining staff, “Muller does not disclose a conveyor unit detached from the collection drum” for the simple reason that *circulating conveyor* 40 is intermediate between *first feeding section* 22.1 and *removal section* 24. The Examining staff is respectfully requested to correct the record of the prosecution history to conform to the actual teachings of Müller *et al.* ‘278.

In paragraph 17, the Examining staff argues that,

“17. The applicant states that Muller does not disclose a transfer of printed products between the collection drum end and the conveyor assembly. In response, the examiner notes that Muller discloses a transfer of printed products between the collection drum end and the conveyor assembly (see at least Muller col. 4, lines 19-30);”;

and in paragraph 18, that:

“18. The applicant states that Muller does not disclose a conveyor device that is arranged adjacent to a collection drum end of the collection drum. In response, the examiner notes that Muller discloses a conveyor device that is arranged adjacent to a collection drum end of the collection drum (see at least applicant’s specification as filed, paragraph 0010).”

In point of fact, the Examining staff is confusing the term “collection drum end” as used in Applicant’s paragraph [0010] with the express teachings of Müller *et al.* ‘278 that,

“[t]he processing drum 14 has, at its *end region* on the left-hand side of FIG. 1, a *first feeding section* 22.1 and, at the other *end*

*region* on the right-hand side of FIG. 1, a *removal section 24.*”<sup>42</sup>

Figure 1 of Müller *et al.* ‘278 illustrates that *first feeding section 22.1* and *removal section 24* are at the axially opposite extremes of “processing drum 14” while *circulating conveyor* 40 is intermediate between *first feeding section 22.1* and *removal section 24*. The Examining staff is respectfully requested to correct the record of the prosecution history to conform to the actual teachings of Müller *et al.* ‘278.

**3. The Examining Staff has failed to comply with the requirement of 37 CFR §1.104(b) and (c) for completeness of Paper No. 20050610.**

**First**, Paper No. 20050610, in its entirety, avers that,

“Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)<sup>43</sup> with uniformly distributed saddles (18) and conveyor elements (34); conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50’) supported on rails (46’); a conveyor unit (48); and working stations (82, 74).”<sup>44</sup>

Nowhere does Paper No. 20050610 address such features set forth in the express language of claim 1, as, by way of example, Applicant’s *conveyor device* that “in the transfer region is arranged adjacent to a collection drum end of the collection drum” or teaches that “for the second rests movable in the conveyor path there is provided a conveyor unit detached from

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<sup>42</sup> Müller *et al.* ‘278, column 3, lines 31-41.

<sup>43</sup> In point of fact, Müller ‘278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

<sup>44</sup> Paper No. 04072005, page 4.

the collection drum.” These are also features of previously presented claims 17 through 23.

**Second**, claim 1 defines a structure in which, “for the second rests movable in the conveyor path there is provided a conveyor unit detached from the collection drum” while claim 16 defines a structure with “a conveyor unit detached from the collection drum”; in contradistinction, the Müller ‘278 patent teaches that:

“[t]he separating elements 42 are spaced apart by a distance A, and are carried by an endless drawing member 46, for example two chains 46’... the endless conveyor member 46 or chains 46’ are guided around the **supporting element 16 of the processing drum 14** and a cylindrical drum-like deflection member 48.”<sup>45</sup>

Where is any suggestion of “detached” in the prior art? In other words, the art represented by the Müller ‘278 patent is incapable of teaching Applicant’s structure with “a conveyor unit detached from the collection drum.”<sup>46</sup> Where is the completeness of a demonstration of anticipation required under 37 CFR §1.104(a), (b) and (c)?<sup>47</sup> Written clarification in compliance with 37 CFR §1.104(a), (b) and (c) is respectfully requested in a non-final Office action.

**Third**, Müller ‘278 describes a structure with,

“**At a first end section of the processing drum, folded printed**

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<sup>45</sup> The significance of this passage of Müller ‘278 is the integration of circulating conveyor 40 and processing drum 14, wholly devoid of Applicant’s teaching of “a conveyor unit detached from the collection drum.”

<sup>46</sup> Claim 1, lines 15 and 16, and claim 16, line 10.

<sup>47</sup> Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 3, August 2005.

products can be deposited in a straddling manner on wall elements of the processing drum by a gripper conveyor. At a second end section, located *at the other end of the processing drum*, printed products that have been processed in the processing drum are removed by a gripper conveyor.”<sup>48</sup>

In its broadest interpretation made without benefit of its drawings, this excerpt from the Müller ‘278 patent might arguably read as positioning a “gripper conveyor” at one end of processing drum 14 to remove printed products from a central portion of processing drum 14 neighboring that “gripper conveyor”; where is any suggestion of Applicant’s teaching of a transfer of “the printed products ... from the collection drum end to the conveyor means device” or “transfer of the printed products between the collection drum end and the conveyor assembly”? Such deficiencies is persuasive evidence of an utter lack of anticipation. Paper No. 04072005 simply does not address every element of claims 1 through 16 as is demanded to demonstrate anticipation of *the invention* defined by the pending claims under 35 U.S.C. §102(b) with the degree of completeness adequate to demonstrate of anticipation required under 37 CFR §1.104(a), (b) and (c)?<sup>49</sup> Written clarification in compliance with 37 CFR §1.104(a), (b) and (c) is respectfully requested in a non-final Office action, in order to accord Applicant an opportunity to respond, contradict or explain any errors found in that clarification.

**Fourth**, where in Müller ‘278 is there found “a device for collecting and processing

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<sup>48</sup> Müller, *et al.* ‘527, column 1, lines 10-23.

<sup>49</sup> Such completeness is mandatory for the Examining staff, and must comply with the dictates laid out by the Direction in, for example, §2131 of the *Manual of Patent Examining Procedure*, 8<sup>th</sup> Ed., Rev. 3, August 2005.

folded printed products that includes a collection drum (14)"? Müller '278 identifies a *processing* drum 14, but not a *collection* drum 14. Is this discrepancy in nomenclature simply a typographic error in Paper No. 20050610? Müller '278 is quite clear that with his novel "processing drum",

"*certain processing steps on the printed products ... are no longer carried out in the processing drum ... .*"<sup>50</sup>

Honnegar '014 also describes,

"an elongate processing drum 12 which is mounted rotatably about its horizontal access 14 ... on a machine frame 18 ...[with] a multiplicity of wall elements 22, which are arranged approximately in axial planes, extend over the entire processing length of the processing drum 12 and are evenly distributed, seen in the circumferential direction ... [with] saddle-shaped rests 24, which run parallel to axis 14 ... in order to advance the printed products 10 deposited in a straddling manner on the rests 24 ... [past] twelve feed stations 30 arranged next to one another along the processing drum 12."<sup>51</sup>

In contradistinction, Applicant explains that in the art such as that represented by EP-A1-0675005,

"The collection drum in the usual manner surged the collection of the printed products. The collected printed products are transferred to the revolving conveyor means and here may be subjected to further working steps, *i.e.* adhesive binding or stapling, wherein adhesive binding is shown in detail in EP-A1-0675005."<sup>52</sup>

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<sup>50</sup> Müller '278, column 2, lines 10-13.

<sup>51</sup> Honneger U.S. patent 5,324,014, column 4, lines 39-69.

<sup>52</sup> Applicant's original specification, page 5, lines 13-16.

and as is explained by Honegger *et al.* U.S. 5.324.014, the text of which patent is expressly incorporated into Müller ‘278<sup>53</sup>,

“[t]he apparatus, which carries out the process, has a processing drum driven rotationally about a horizontal axis, and a plurality of saddle-shaped rests are distributed regularly about the drum in the circumferential direction.”<sup>54</sup>

This rejection therefore rests upon the entirety of an inaccurate characterization of the prior art as represented by Müller ‘278, namely the assertion that,

“Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)<sup>55</sup> with uniformly distributed saddles (18) and conveyor elements (34)  
...”<sup>56</sup>

This is inaccurate because Müller ‘278 itself, expressly teaches that:

“[a]ccording to the invention, certain processing steps on the printed products or the addition of further products to the printed products are no longer carried out in the processing drum, but in a circulating conveyor.”<sup>57</sup>

It is unclear why the Examining staff has argued that “Müller discloses a device for collecting and processing folded printed products”, when Müller ‘278 itself denies that

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<sup>53</sup> See Müller ‘278 at column 1, beginning with line 8.

<sup>54</sup> Honneger U.S. patent 5,324,014, column 1, lines 53-57.

<sup>55</sup> In point of fact, Müller ‘278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

<sup>56</sup> Paper No. 04072005, page 4.

<sup>57</sup> See Müller ‘278 at column 2, lines 9-12.

certain processing steps are carried out on his processing drum;<sup>58</sup> given this discrepancy, Paper No. 04072005 fails to meet the requirements for completeness required under 37 CFR §1.104(b) and (c). Written clarification in subsequent Office correspondence is respectfully requested, to particularly identify where Müller ‘278 “discloses a device for ... processing folded printed products.” Absent this, the rejection fails to make a *prima facie* demonstration under 35 U.S.C. §102(b) of either the patenting or description in a printed publication of Applicant’s invention prior to the date of this application.

**Fifth,** the Examining staff continues in this vein by asserting that:

“Müller discloses a ... conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50’) supported on rails (46’); a conveyor unit (48); and working stations (82, 74).”<sup>59</sup>

This assertion of the Examining staff is contradicted by the express teachings of Müller ‘278. In point of fact, Müller ‘278 expressly states that the:

“circulating conveyor 40 has separating elements 42 which correspond to wall elements 18 of the processing drum 14 and separate receiving compartments 44, which correspond to the compartments 32 of the processing drum 14.”<sup>60</sup>

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<sup>58</sup> See Müller ‘278 at column 2, lines 9-12, where Müller ‘278 itself, expressly teaches that: “[a]ccording to the invention, certain processing steps on the printed products or the addition of further products to the printed products are no longer carried out in the processing drum, but in a circulating conveyor.” This contradicts the arguments advanced by the Examining staff in support of its anticipation rejection.

<sup>59</sup> Paper No. 04072005, page 4.

<sup>60</sup> Müller ‘278 at column 4, beginning with line 19.

Wholly absent from this teaching are both of the Examining staff's (i) "conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46")" and (ii) "conveyor means (40) with second saddles (42)", as well as the Examining staff's (iii) "conveyor means (40) with second saddles (42), having bending devices". Does the Examining staff intend to refer to "rest saddle 52"?<sup>61</sup> It is unclear why the Examining staff has argued that,

"Müller discloses ... conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46")", when Müller '278 states that reference numeral 42 refers to "separating elements 42" and that "separating elements 42 ... correspond to wall elements 18";

given these discrepancies, Paper No. 04072005 fails to meet the requirements for completeness required under 37 CFR §1.104(b) and (c). Written clarification in subsequent Office correspondence is respectfully requested, to particularly identify where:

- (i) Müller '278 "discloses ... conveyor means (40) with second saddles (42), having bending devices, in a transfer region (50') supported on rails (46")",
- (ii) Müller '278 "discloses ... conveyor means (40) with second saddles (42)", and
- (iii) Müller '278 "discloses ... conveyor means (40) with second saddles (42), having bending devices".

Absent clarification in conformance with the requirements for completeness under 37 CFR §1.104(b) and (c), the rejection fails to make a *prim a facie* showing of obviousness under 35 U.S.C. §103(a).

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<sup>61</sup> Müller '278, column 4, line 59.

4. **The Examining Staff has failed to comply with the requirement under 35 U.S.C. §102(b) by considering the entirety of the subject matter which the Applicant regards as “the invention.”**

Müller ‘278 claims priority from Swiss patent No. CH19940001316 199440428, and was published as EP0681979 (B1). The evidence of record, as set forth in Applicant’s original specification, identified Müller ‘278 as EP-B1-0681979.<sup>62</sup> As explained by Applicant in paragraph [0010] of the original specification, Müller ‘278 contemplates a structure with,

“[o]ne possibility for the flexible use of space for various working steps is disclosed in EP-B1-061979. With this device for collecting and processing folded printed products a collection drum is combined with a revolving conveyor means. The collection drum in the usual manner serves the collection of the printed products. The collected printed products are transferred to the revolving conveyor means and here may be subjected to further working steps, *i.e.*, adhesive binding or stapling, wherein adhesive binding is shown in detail in EP-A1-0675005. The axial direction of the collection drum and the conveyor direction in the revolving conveyor means ... [being] perpendicular to one another ... . On collection of the printed products these are moved along on the rests to a first collection drum end. The collection drum end is determined by the end of the rests of the collection drum. **The hub of the collection drum on the other hand extends beyond the end of the collection drum.** The revolving conveyor means is arranged adjacent to the collection drum end. Chains which serve as conveyor devices in the revolving conveyor means and engage radially on the inside of its rests are led around that part of the hub projecting beyond the collection drum end. **This part of the hub thus serves as diverting means in the revolving conveyor means and thus becomes an integral part of this.** A *common drive* thus simultaneously provides for the rotation

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<sup>62</sup>

Original specification, paragraph [0010], lines 11 and 12.

movement of the collection drum and for the conveyor movement of the rests in the revolving conveyor means. The distance between the rests moved in the revolving path is dimensioned such that these, when they are conveyed in the region of the collection drum, are flush with the rests of the collection drum, by which means a simple transfer of the printed products from the collection drum to the revolving means, based on the same design, may be transferred to a further collection drum arranged displayed to the first collection drum but may also be led back to the first collection drum on a lower side ... of the revolving conveyor means and transferred to a further collection section of the first collection drum.”<sup>63</sup>

The difficulty with the structure disclosed in Müller ‘278 is then discussed by Applicant in paragraph [0011]:

“[a]lthough this design permits a higher flexibility of the use of space, however with this device too the use of the space is **restricted** since the folded printed products in each case may only be transferred in the diverting region of the revolving conveyor means from the collection drum to the conveyor means and from the conveyor means to the collection drum.”<sup>64</sup>

In contradistinction, claims 1, 2, 5 through 13, 17, 19 and 21 through 23 define a structure in which “the conveyor means in the transfer region is arranged adjacent to a collection drum end of the collection drum . . . .” This feature is not found in Müller ‘278. Under 35 U.S.C. § 102(b), it is error to assume that two structures are the same or equivalent simply because they perform the same function. The Federal Circuit has held it error to assume that two structures are the same or equivalent simply because they perform the same function. *Roton Barrier, Inc. v. Stanley Works*, 79 F.3d 1112, 1126-27 (Fed. Cir. 1996); *Pennwalt Corp. v.*

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<sup>63</sup> Original specification, paragraph [0010]; emphasis added.

<sup>64</sup> Original specification, paragraph [0011].

*Durand-Wayland, Inc.*, 833 F.2d 931, 934 (Fed. Cir. 1987) (en banc) (“Pennwalt erroneously argues that, if an accused structure performs the function required by the claim, it is per se structurally equivalent”), *cert. denied*, 485 U.S. 961 (1988). Infringement (or anticipation) is found only if the claimed function is performed by either the same structure (or acts) that the specification describes or else by an equivalent of the structure (or acts). *Texas Instruments Inc. v. United States Int'l Trade Comm'n*, 805 F.2d 1558, 1562, 231 USPQ 833, 834-35 (Fed. Cir. 1986). Accordingly, this rejection is improper under the all elements rule. Withdrawal of the rejection and allowance of claims 1, 2, 5 through 13, 17, 19 and 21 through 23 is respectfully requested.

**In summary**, this rejection rests upon an inaccurate characterization of the prior art as represented by Müller ‘278, such as the assertion by the Examining staff that,

“Müller discloses a device for collecting and processing folded printed products that includes a collection drum (14)<sup>65</sup> with uniformly distributed saddles (18) and conveyor elements (34) ... ”,<sup>66</sup>

is inaccurate because Müller ‘278 itself expressly teaches that with a *processing drum*:

“[a]ccording to the invention, certain processing steps on the printed products or the addition of further products to the printed products are no longer carried out in the processing drum, but in a circulating conveyor”,<sup>67</sup>

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<sup>65</sup> In point of fact, Müller ‘278 teaches a *processing drum 14*, rather than the *collection drum* asserted by the Examiner.

<sup>66</sup> Paper No. 04072005, page 4.

<sup>67</sup> See Müller ‘278 at column 2, lines 9-12.

while Applicant teaches that a *collection drum* is not a device for collecting **and** processing folded printed products as averred by the Examining staff. Applicant explains a *collection drum* as serving “the collection of printed products ... [and the] collected printed products are transferred to the revolving conveyor and here may be subjected to further working steps, *i.e.*, adhesive binding or stapling ... .”<sup>68</sup> The technique of the Examining staff for formulating a rejection under 35 U.S.C. §102(b) by inaccurately characterizing the teachings of Müller ‘278 will not support a rejection under 35 U.S.C. §102(b), because the Examining staff has simply attributed the language of claims 1, 2, 5 through 13, 17, 19 and 21 through 23 to Müller ‘278 without any demonstration that Applicant’s invention as defined by the pending claims, was disclosed by Müller ‘278. Consequently, the rejection fails to make a *prima facie* demonstration under 35 U.S.C. §102(b) of either the patenting or description in a printed publication of Applicant’s invention prior to the date of this application. Withdrawal of this rejection and allowance of claims 1, 2, 5 through 13, 17, 19 and 21 through 23 is respectfully requested.

**Rejection Of Claims 3 And 14 Under 35 USC §103(a)**

Claims 3 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muller (US 5,562,278) in view of Mowry *et al.* (US 4,641,825). Applicant respectfully traverses this rejection for the following reasons.

In Paper No. 20060623, the Examining staff urges that:

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<sup>68</sup> Applicant’s specification, page 5, lines 14-17.

“Muller discloses all the limitations of the claims, but it does not disclose bending elements integrated with the second rests. In fact, Muller does not disclose that the staples are bent at all. However, Mowry discloses a similar device that includes bending elements (72) integrated with rests (13) for the purpose of bending the staples provided by a stapling apparatus to prevent the staples from falling out of a bound printed product as is commonly known in the art. It would have been obvious for a person of ordinary skill in the art at the time of the applicant’s invention to utilize bending elements integrated with the second rests, as disclosed by Mowry for the purpose of bending the staples provided by a stapling apparatus to prevent the staples from falling out of a bound printed product.”<sup>69</sup>

The Examining staff ignores the fact that although Mowry *et al* ‘825 is remarkable complete in its teaching of both collator and stitching with “support bars or saddles 13” cooperating with “crimpers or anvils 72”,<sup>70</sup> it nowhere purports to remedy the deficiencies noted in the foregoing paragraphs found the interpretation by the Examining staff of primary reference. Accordingly, there is no basis for maintaining this rejection. Its withdrawal is respectfully urged.

**Rejection of Claims 4, 18 & 20 Under 35 U.S.C. §103(a)**

Claims 4, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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<sup>69</sup> The Examining staff is invited to note that the technology taught by Mowry ‘825 does not include the Examining staff’s “a similar device that includes bending elements (72) integrated with rests (13) for the purpose of bending the staples provided by a stapling apparatus to prevent the staples from falling out of a bound printed product”; in point of fact, Mowry ‘825 is directed to *stitching* rather than to *stapling* as is asserted by the Examining staff.

<sup>70</sup> The Examining staff is invited to note that the terminology used by Mowry ‘825 does not include the Examining staff’s “bending elements (72)” or “rests (13).”

Muller (US 5,562,278) in view of Hansch *et al.* (US 5,172,897). Applicant respectfully traverses this rejection for the following reasons.

In support of this rejection, the Examining staff urges that:

“Muller discloses all the limitations of the claims, but it does not disclose that the stapling apparatus is movably mounted on a rail guided approximately parallel to the conveyor path. However, Hansch discloses a similar device that includes a stapling apparatus (28) that is movably mounted on a rail (26) guided approximately parallel to the conveyor path for the purpose of permanently assigning to a stapler head to each support allowing the stapling heads of a stapling head arrangement to be mutually offset in the longitudinal direction of the supports. It is thus possible, for example, for each second stapling head to be slightly offset in relation to the other stapling heads arranged in a plane. All the staples do not then come to be located above one another during stacking of the stapled sheets (see col. 15, lines 1-15). It would have been obvious for a person of ordinary skill in the art, at the time of the applicant’s invention to modify Muller by utilizing a stapling apparatus that is movably mounted on a rail guided approximately parallel to the conveyor path, as disclosed by Hansch, for the purpose of permanently assigning to a stapler head to each support allowing the stapling heads of a stapling head arrangement to be mutually offset in the longitudinal direction of the supports. It is thus possible, for example, for each second stapling head to be slightly offset in relation to the other stapling heads arranged in a plane. All the staples do not then come to be located above one another during stacking of the stapled sheets.”

The Examining staff ignores the fact that although Hansch *et al* ‘897 is remarkable complete in its teaching of both collection and stapling, it nowhere purports to remedy the deficiencies noted in the foregoing paragraphs found the interpretation by the Examining staff of primary reference. Accordingly, there is no basis for maintaining this rejection. Its withdrawal is

respectfully urged.

It is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

Respectfully submitted,

  
Robert E. Bushnell,  
Attorney for the Applicant  
Registration No.: 27,774

1522 "K" Street N.W., Suite 300  
Washington, D.C. 20005  
(202) 408-9040

Folio: P56988  
Date: 1/3/07  
I.D.: REB